



DFW/B.

PATENT  
ATTORNEY DOCKET NO. 061351-5001-01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Paul KORNBLITH, et al.

Application No.: 09/040,161

Confirmation No.: 1498

Filed: March 17, 1998

Group Art Unit: 1651

Date Allowed: December 17, 2004

Examiner: Ralph Gitomer

/ For: PRECISE EFFICACY ASSAY  
METHODS FOR ACTIVE AGENTS  
-- INCLUDING CHEMOTHERAPEUTIC  
AGENTS

Commissioner for Patents  
**CUSTOMER WINDOW**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

**REQUEST FOR RETURN COPY OF PTO-1449**

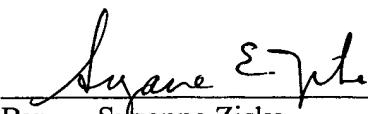
No executed copy has been received of the Form PTO-1449, filed on May 28, 2004 as shown by the attached copy of our PTO postcard receipt. Attached hereto is a copy of the IDS, PTO 1449 form and copies of documents B2-B5 and C38-C45 filed May 28, 2004 cited thereon to be

Attorney Docket No. 061351-5001-01  
Application No. 09/040,161  
Page 2

forwarded to the Examiner for consideration. Copies of the U.S. patent documents have not been provided. If there are any questions, please call the undersigned at the telephone number below.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

  
By: Suzanne Ziska  
Reg. No. 43,371

Dated: March 2, 2005

Customer No. 09629  
**MORGAN, LEWIS & BOCKIUS LLP**  
**1111 Pennsylvania Avenue, NW**  
**Washington, DC 20004**  
**(202) 739-3000**  
**FAX (202) 739-3001**



PTI-001CN (8803/2)

The "RECEIVED" stamp of the Patent Office imprinted hereon acknowledges the filing  
of:

Certificate of First Class Mailing (1 pg.); Transmittal Form (1 pg.); Supplemental  
Information Disclosure Statement (3 pgs.); Form PTO-1449 (2 pgs.); Copies of Cited  
References A23-A33, B2-B5 and C38-C45; and this Return Receipt Postcard.

Name of Applicant: Kornblith

Serial Number: 09/040,161

Atty: DAWilson/MPattaropong/ew

Date: May 26, 2004

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PTI-001CN (8803/2)

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of:

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Name of Applicant: Kornblith

Serial Number: 09/040,161

Atty: DAWilson/MPattaropong/ew

Date: May 26, 2004

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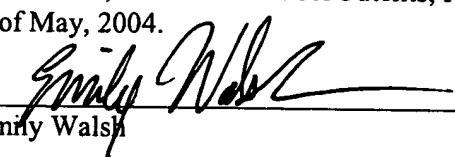
PATENT  
Attorney Docket No. PTI-001CN

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): Kornblith CONFIRMATION NO.: 1498  
SERIAL NO.: 09/040,161 GROUP NO.: 1651  
FILING DATE: March 17, 1998 EXAMINER: Gitomer, R.  
TITLE: METHOD FOR PREPARING CELL CULTURES FROM  
BIOLOGICAL SPECIMENS FOR CHEMOTHERAPEUTIC AND  
OTHER ASSAYS

**CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. 1.8**

I hereby certify that this correspondence, and any document(s) referred to as enclosed herein, is/are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26 day of May, 2004.

  
Emily Walsh

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith are:

1. Transmittal Form (1 pg.);
2. Supplemental Information Disclosure Statement (3 pgs.);
3. Form PTO-1449 (2 pgs.);
4. Copies of Cited References A23-A33, B2-B5 and C38-C45; and a
5. Return Receipt Postcard.

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MAR 02 2005  
PATENT TRADEMARK OFFICE

# TRANSMITTAL FORM

Application Serial Number	09/040,161
Filing Date	March 17, 1998
First Named Inventor	Kornblith
Group Art Unit	1651
Examiner Name	Gitomer, R.
Attorney Docket No.	PTI-001CN
Patent No.	Not applicable
Issue Date	Not applicable

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <ul style="list-style-type: none"> <li><input type="checkbox"/> Check Attached</li> <li><input type="checkbox"/> Copy of Fee Transmittal Form</li> </ul>	<input type="checkbox"/> Copy of Notice to File Missing Parts of Application <ul style="list-style-type: none"> <li><input type="checkbox"/> Formal Drawing(s)</li> </ul>	<input type="checkbox"/> Notice of Appeal to Board of Patent Appeals and Interferences <ul style="list-style-type: none"> <li><input type="checkbox"/> Appeal Brief (in triplicate)</li> </ul>
<input type="checkbox"/> Amendment/Response <ul style="list-style-type: none"> <li><input type="checkbox"/> Preliminary</li> <li><input type="checkbox"/> After Final</li> <li><input type="checkbox"/> Affidavits/declaration(s)</li> <li><input type="checkbox"/> Letter to Official Draftsperson including Drawings</li> <li>[Total Sheets _____]</li> </ul>	<input type="checkbox"/> Request For Continued Examination (RCE) Transmittal <ul style="list-style-type: none"> <li><input type="checkbox"/> Power of Attorney (Revocation of Prior Powers)</li> </ul>	<input type="checkbox"/> Status Inquiry <ul style="list-style-type: none"> <li><input checked="" type="checkbox"/> Return Receipt Postcard</li> <li><input checked="" type="checkbox"/> Certificate of First Class Mailing under 37 C.F.R. 1.8</li> </ul>
<input type="checkbox"/> Petition for Extension of Time	<input type="checkbox"/> Terminal Disclaimer <ul style="list-style-type: none"> <li><input type="checkbox"/> Executed Declaration and Power of Attorney for Utility or Design Patent Application</li> </ul>	<input type="checkbox"/> Certificate of Facsimile Transmission under 37 C.F.R. 1.8 <ul style="list-style-type: none"> <li><input type="checkbox"/> Additional Enclosure(s) (please identify below)</li> </ul>
<input checked="" type="checkbox"/> Supplemental Information Disclosure Statement <ul style="list-style-type: none"> <li><input checked="" type="checkbox"/> Form PTO-1449</li> <li><input checked="" type="checkbox"/> Copies of IDS Citations A23-A33, B2-B5 and C38-C45</li> </ul>	<input type="checkbox"/> Small Entity Statement <ul style="list-style-type: none"> <li><input type="checkbox"/> CD(s) for large table or computer program</li> </ul>	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Amendment After Allowance <ul style="list-style-type: none"> <li><input type="checkbox"/> Request for Certificate of Correction</li> <li><input type="checkbox"/> Certificate of Correction (in duplicate)</li> </ul>	
<input type="checkbox"/> Sequence Listing submission <ul style="list-style-type: none"> <li><input type="checkbox"/> Paper Copy/CD</li> <li><input type="checkbox"/> Computer Readable Copy</li> <li><input type="checkbox"/> Statement verifying identity of above</li> </ul>		

## CORRESPONDENCE ADDRESS

Direct all correspondence to: Patent Administrator  
 Testa, Hurwitz & Thibeault, LLP  
 High Street Tower  
 125 High Street  
 Boston, MA 02110  
 Tel. No.: (617) 248-7000  
 Fax No.: (617) 248-7100

## SIGNATURE BLOCK

Respectfully submitted,

Daniel A. Wilson  
 Attorney for Applicant  
 Testa, Hurwitz & Thibeault, LLP  
 High Street Tower  
 125 High Street  
 Boston, MA 02110



PATENT  
Attorney Docket No. PTI-001CN

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): Kornblith CONFIRMATION NO.: 1498  
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BIOLOGICAL SPECIMENS FOR CHEMOTHERAPEUTIC AND  
OTHER ASSAYS

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Sir:

In accordance with the provisions of 37 C.F.R. 1.97 and 1.98, Applicants hereby make of record the patents and publications listed on the accompanying Form PTO-1449, and other information contained herein, for consideration by the Examiner in connection with the examination of the above-identified patent application. Copies of the patents and publications are enclosed.

In addition, Applicants wish to inform the Examiner about the following patent applications, and the contents of their file wrappers, including all Office actions issued therein:

- 1) U.S.S.N. 10/208,480, entitled "Method for Preparing Cell Cultures from Biological Specimens for Chemotherapeutic and Other Assays," filed on July 30, 2002, and published on February 5, 2004, as U.S. Application Publication No. 2004/0023375 (Reference A31).
- 2) U.S.S.N. 10/336,659, entitled "Methods for Assessing Efficacy of Chemotherapeutic Agents," filed on January 2, 2003, and published on April 15, 2004, as U.S. Application Publication No. 2004/0072722 (Reference A32).

**REMARKS**

In accordance with the provisions of 37 C.F.R. 1.97, this statement is being filed (CHECK ONE):

(1) within three (3) months of the filing date of a national application other than a continued prosecution application under 37 C.F.R. 1.53(d), or within three (3) months of the date of entry of the national stage as set forth in 37 C.F.R. 1.491 in an international application, or before the mailing of the first Office action on the merits, or before the mailing of a first Office action after the filing of a request for continued examination under 37 C.F.R. 1.114; or

(2) after the period defined in (1) but before the mailing date of a final action or a notice of allowance under 37 C.F.R. 1.311, and

the requisite Statement is below, OR

the requisite fee under 37 C.F.R. 1.17(p), namely \$180.00, is included herein, or

(3) after the mailing date of a final action or notice of allowance but before the payment of the issue fee, AND

the requisite Statement is below, AND

the requisite petition fee under 37 C.F.R. 1.17(p), namely \$180.00 is included herein.

It is respectfully requested that each of the patents and publications listed on the attached Form PTO-1449, and other information contained herein, be made of record in this application.

#### STATEMENT

As required under 37 C.F.R. 1.97(e), Applicant(s), through the undersigned, hereby state either that [check the appropriate space only if either (2) or (3) is checked on the previous page and the Statement is required]:

1. Each item of information contained in the Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement; or

2. No item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this Statement after making reasonable inquiry, no item of information contained in the Information Disclosure Statement was known to any individual designated in 37 C.F.R.

**1.56(c) more than three months prior to the filing of the Information Disclosure Statement.**

Respectfully submitted,



Daniel A. Wilson  
Attorney for Applicant  
Testa, Hurwitz & Thibeault, LLP  
High Street Tower  
125 High Street  
Boston, Massachusetts 02110

Date: May 26, 2004  
Reg. No. 45,508

Tel. No.: (617) 248-7226  
Fax No.: (617) 248-7100

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SHEET 1 OF 2

FORM PTO - 1449  SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT				ATTORNEY DOCKET NO.: PTI-001CN  APPLICANT(S): Kornblith  SERIAL NO.: 09/040,161  FILING DATE: March 17, 1998 GROUP: 1651					
U.S. PATENT DOCUMENTS									
EXAM. INIT.		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE		
	A23	4,559,299	12/17/85	Rotman			02/04/83		
	A24	4,816,395	03/28/89	Hancock <i>et al.</i>			12/19/85		
	A25	5,403,574	04/04/95	Piwnica-Worms			06/26/92		
	A26	5,705,270	01/06/98	Soon-Shiong <i>et al.</i>			06/07/95		
	A27	6,111,092	08/29/00	Williamson			06/03/98		
	A28	6,664,062 B1	12/16/03	Stanton			09/24/01		
	A29	2002/0168679A1	11/14/02	Naus <i>et al.</i>			06/11/98		
	A30	2002/0192638A1	12/19/02	Kornblith			07/26/02		
	A31	2004/0023375A1	02/05/04	Kornblith <i>et al.</i>			07/30/02		
	A32	2004/0072722A1	04/15/04	Kornblith <i>et al.</i>			01/02/03		
	A33	2004/0086888 A1	05/06/04	Kornblith <i>et al.</i>			10/18/01		
FOREIGN PATENT DOCUMENTS									
EXAM. INIT.		DOCUMENT NUMBER	DATE	COUNTRY CODE	CLASS	SUB CLASS	FILING DATE	ABSTRACT ONLY	ENGLISH LANG (Y/N)
	B2	WO98/02038	01/22/98	PCT			07/10/97	N	Y
	B3	WO02/33117A2	04/25/02	PCT			10/18/01	N	Y
	B4	WO2004/015065A2	02/19/04	PCT			07/30/03	N	Y
	B5	WO2004/035833A1	04/29/04	PCT			10/10/03	N	Y
EXAMINER				DATE CONSIDERED					



<b>FORM PTO - 1449</b>  <b>SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT</b>		ATTORNEY DOCKET NO.: PTI-001CN  APPLICANT(S): Kornblith  SERIAL NO.: 09/040,161  FILING DATE: March 17, 1998 GROUP: 1651
<b>OTHER ART, JOURNAL ARTICLES, ETC.</b>		
<b>EXAM. INIT.</b>	<b>OTHER DOCUMENTS:</b> (Including Author, Title, Date, Relevant Pages, Place of Publication)	
C38	Freshney, R.I., <i>Culture of Animal Cells: A Manual of Basic Technique</i> , 2nd edition, pp. 107, 124-126, 179, 233-234, 290 (1987).	
C39	Guo <i>et al.</i> , "Direct fluorescence analysis of genetic polymorphisms by hybridization with oligonucleotide arrays on glass supports," <i>Nucleic Acids Research</i> 22(24):5456-5465 (1994).	
C40	Pfost <i>et al.</i> , "A SNPshot: pharmacogenetics and the future of drug therapy," <i>TIBTECH</i> 18:334-338 (August, 2000).	
C41	Stephens, J.C., "Single-nucleotide Polymorphisms, Haplotypes, and Their Relevance to Pharmacogenetics," <i>Molecular Diagnosis</i> 4(4):309-317 (1999).	
C42	Tannock <i>et al.</i> , <i>The Basic Science of Oncology</i> , 2nd edition, pp. 247-248, 261-265, 303-306(1992).	
C43	Becton-Dickinson Catalog, Anti-Cytokeratin (CAM 5.2) Reagent, pp. 1-11 (1997).	
C44	Boehringer Mannheim Catalog, Anti-Cytokeratin AE1/AE3, (1996).	
C45	DAKO Catalog, Specification Sheet for Monoclonal Mouse Anti-Human Epithelial Membrane Antigen, pp. 1-2 (1996).	
<b>EXAMINER</b>		<b>DATE CONSIDERED</b>

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